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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 32

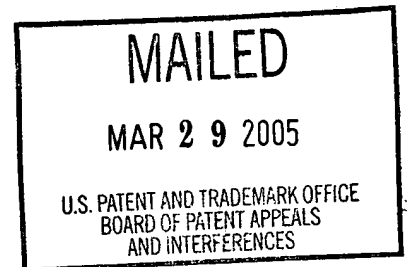
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAEED GANJI

Appeal No. 2004-2122
Application No. 09/346,354

HEARD: March 6, 2005



Before RUGGIERO, DIXON, and MACDONALD, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4, 9, and 11, which are all of the claims pending in this application.

We REVERSE, ENTER A NEW GROUNDS OF REJECTION and REMAND to the examiner for further consideration.

BACKGROUND

Appellant's invention relates to a printer description file format generator. An understanding of the invention can be derived from a reading of exemplary claims 1 and 4, which are reproduced below.

1. A development environment for producing a PostScript® printer description (PPD) text file associated with a printer, the development environment comprising:

a base PPD text file that comprises information regarding the printer, the information including text in a first language, the base PPD text file adapted for a first software platform; and

a PPD generator adapted to import the base PPD text file and to generate therefrom a second PPD text file that includes text translated from the first language to a second language.

4. A method for revising a PostScript® printer description (PPD) text file associated with a printer, the method comprising:

providing a base PPD text file that comprises information regarding the printer, the information including text in a first language, the base PPD text file adapted for a first software platform, and a build file that comprises information as to how the base PPD text file should be edited to provide a second PPD text file that includes text translated from the first language to a second language;

modifying the base PPD text file to provide a revised PPD text file;
and

implementing the build file to generate a second PPD text file from the revised PPD text file.

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The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Andrews et al. (Andrews)	5,768,564	Jun. 16, 1998
deSilva	5,857,064	Jan. 05, 1999

Claims 1-4, 9 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Andrews in view of deSilva.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 25, mailed Aug. 27, 2003) for the examiner's reasoning in support of the rejection, and to appellant's brief (Paper No. 24, filed Jun. 11, 2003) and reply brief (Paper No. 27, filed Oct. 27, 2003) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

From our review of the teachings of deSilva and Andrews, we generally agree with appellant's arguments in the brief and the reply brief that neither reference teaches or suggests the production, generation, or revision of a Postscript® printer description (PPD) text file associated with a printer. We find the only teaching of such

methodologies in appellant's admitted prior art which is not applied by the examiner. Furthermore, we do not find that the conversion of complex graphical primitives in deSilva or the translation of source code programs in Andrews would have taught or fairly suggested the invention as recited in independent claims 1, 3, and 4.

The examiner maintains that "the developer logically would worry about whether his development would be usable by the computer system because the computer may not be able to read the PPD text file if the PPD text file is not written into a language understandable by the computer" (See answer at page 14.) Here, the examiner has confused the rewriting of a program into a different computer language with the claimed natural language text which is translated and the variation of the text file for different computer platforms. We do not find the examiner's position persuasive. Therefore, we find that the examiner has not established a *prima facie* case of obviousness of the invention as claimed, and we cannot sustain the rejection of independent claims 1, 3, and 4 and their dependent claims.

NEW GROUNDS OF REJECTION

We institute a rejection of claims 1, 2, 9, and 11 of this application under the authority provided by 37 CFR § 41.50(b). We make a rejection of independent claim 1 and dependent claims 2, 9, and 11 under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim the invention sought to be patented. Here, we find that neither the specification nor the claim language describes or identifies what

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a "development environment" is with respect to the four statutory classes of statutory subject matter. Therefore, we are unable to determine what statutory class of invention the claimed invention is limited to. Section 101 of Title 35 establishes the four classes of statutory inventions.

35 U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

We further add that if the claimed invention is to be limited to a machine or article of manufacture, there must be some structure or medium in which the invention is embodied. Under the current Office examination guidelines for computer-related inventions, data structures not claimed as embodied in computer-readable media are not statutory. See Manual of Patent Examining Procedure (MPEP) § 2106 at 2100-13 (8th ed., Rev. 2, May 2004), under the heading "Functional Descriptive Material: 'Data Structures' Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se." We leave this determination to the examiner upon further consideration of the claimed and disclosed invention.

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REMAND

We further remand this application to the examiner, under the authority provided by 37 CFR § 41.50(a)(1), to consider a rejection of claims 3 and 4 under 35 U.S.C. § 102 or in the alternative under 35 U.S.C. § 103 as being unpatentable over admitted methodology in the prior art subject matter described in the background of the invention at pages 1-3 of the specification. In the claimed invention, we find no limitation that these methods are performed in a non-manual process which would distinguish the process from the manual methods performed by the disclosed engineer in the specification.

The rejection of claims 1-4, 9, and 11 under 35 U.S.C. § 103 being unpatentable over deSilva and Andrews is reversed and a new grounds of rejection is made under 35 U.S.C. § 112, second paragraph. This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board. This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4, 9 and 11 under 35 U.S.C. § 103 is reversed, we enter a new grounds of rejection under 37 CFR 41.50(b) and remand this application under 37 CFR 41.50(a)(1).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED and REMANDED

Ja Russin
JOSEPH E. BLU

JOSEPH F. RUGGIERO
Administrative Patent Judge

Joseph L. Dixon

JOSEPH L. DIXON
Administrative Patent Judge

Allen MacDonald

ALLEN R. MACDONALD
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